Remarks

Claims 13-15 and 58-77 are pending in this application. Applicants note that claims 60, 68 and 70-75 are currently withdrawn from consideration. These claims are not deleted from this application because a request for rejoinder will be filed at an appropriate time. Claims 13 and 60 are amended in this paper to remove the recitation of "prevention." No new matter has been added.

Applicants respectfully submit that the pending claims are allowable at least for the following reasons.

A. The Rejection Under 35 U.S.C. § 112 Should Be Withdrawn

On pages 3-7 of the Office Action, claims 13-15, 58-59, 61-67, and 69 are rejected as allegedly not enabled. In particular, based on the Examiner's analysis of the factors set forth in *In re Wands*, 8 U.S.P.Q. 1400 (Fed. Cir. 1988), it is alleged that the methods of "prevention" are not enabled. (Office Action, pages 4-7). Applicants respectfully disagree, particularly in view of the fact that the specification discloses the compounds, compositions, doses and routes of administration, and specific disorders to be prevented, and no undue experimentation is required for those skilled in the art to practice the invention as claimed. Be that as it may, however, the claims are amended to remove the recitation of "prevention" solely to expedite the prosecution of this application. Thus, Applicants respectfully request that the rejection of claims under 35 U.S.C. § 112 be withdrawn.

B. The Rejection Under 35 U.S.C. § 102(e)[1] Should Be Withdrawn

On pages 8-9 of the Office Action, claims 13-15, 58-59, 61-67, and 69 are rejected as allegedly obvious over U.S. Patent No. 6,391,875 to Morgan *et al.* ("Morgan") in view of U.S. Publication No. 2003/0022942 by Young ("Young").

Without addressing the substance of the rejection, Applicants respectfully point out that Young, although having a priority date of January 29, 1998, was not first published until August 29, 2000. As the current application has a priority date of March

[1] Although the Office Action indicates that the claims are rejected under 35 U.S.C. § 102(e), it appears that the rejection is actually under 35 U.S.C. § 103. For example, the Examiner cited two references, recognizing that Morgan reference fails to disclose all of the limitations of the pending claims. (See Office Action, page 8). In addition, phrases such as "it would have been obvious" or "one would have been motivated" are used throughout the rejection, evidencing that the rejection is under 35 U.S.C. § 103.

1, 1999, Young is a §102(e) reference. However, Applicants respectfully state that Young and this application were both assigned to, and thus commonly owned by, Sepracor Inc. at the time of this invention. Therefore, Young cannot constitute prior art to this application. (35 U.S.C. § 103(c)).

As Young is not prior art, Applicants respectfully request that this rejection be withdrawn.

C. The Finality of the Rejections Should Be Withdrawn

In the Office Action, it is indicated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action," and thus the Office Action is made final. (*See* Office Action, page 9). However, Applicants respectfully point out that it is impermissible to make the first office action after a Request for Continued Examination ("RCE") final based on the assertion that applicant's amendment necessitated new grounds of rejection.

Rather, the first office action after an RCE can be made final only if: 1) the claims are drawn to the same invention claimed in the earlier application; and 2) the claims would have been properly finally rejected on the grounds and art of record in the next office action if they had been entered in the earlier application, *i.e.*, before the RCE. (*See Manual of Patent Examining Procedure* ("MPEP"), §§ 706.07(b) and (h)). Applicants respectfully point out that the pending claims would not have been properly finally rejected on the grounds and art of record because, for example, the Examiner's rejection relies on art which was not cited in the previous office action.[2] Thus, Applicants respectfully request that the finality of the Office Action be withdrawn.

Conclusion

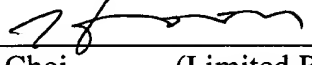
For the foregoing reasons, Applicants respectfully submit that all of the pending claims are in allowable condition, and thus request that the rejection of the pending claims be withdrawn.

[2] Furthermore, Applicants respectfully submit that the next office action, if necessary, also cannot be final because a second office action may not be made final where, like here, a § 102(e) reference cited by the examine in connection with a rejection under § 103 is disqualified by applicant's statement of common ownership. (*See* MPEP, § 706.07(a)).

No fee is believed due for this submission. Should any fees be due for this submission or to avoid abandonment of the application, please charge such fees to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date July 5, 2006



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